Remarks:

Claims 1-16 and 21 are pending. It is submitted that the application is in condition for allowance. Accordingly, reconsideration and reexamination are respectfully requested.

§103 Rejection(s):

Claims 1-16 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,233,641 to Maeda (hereafter "Maeda") in view of U.S. Patent No. 5,202,912 to Breeden et al. (hereafter "Breeden"") and further in view of U.S. Pub. No. 2003/0002476 to Chung et al. (hereafter "Chung"). This rejection is respectfully traversed.

According to MPEP §2143,[1] to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. It is assumed that the §103 rejection is based on the teaching-suggestion-motivation (TSM) rationale. If this is incorrect, Applicant requests that the Examiner clearly articulate the rationale used as the basis for the §103 rejection.

Under the TSM rationale:

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Maeda fails to teach or suggest all of the elements recited in claim 1, as amended. As admitted by the Examiner, Maeda fails to teach or suggest (1) wherein the first terminal communicates over a voice over internet protocol (VOIP) network and the second terminal communicates over public switched telephone network (PSTN); (2) wherein the VOIP and the PSTN networks are connected by way of a trunk gateway; and (3) wherein the second terminal

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[1] *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007).

generates a ring back tone according to the ring back tone data included in the response message, as recited in claim 1.

Respectfully, Maeda also fails to teach or suggest (4) generating ring back tone data independently by the first terminal; (5) inserting the ring back tone data into a response message by the first terminal, in response to the call setup request; and (6) and transmitting the response message from the first terminal to the second terminal over the VOIP network." That is, Maeda merely discloses that telephone set 10 generates a ring back tone while a call is being connected. See column 4, lines 5-7. Particularly, the Examiner is reminded that a VOIP phone as recited in claim 1 (i.e., the first terminal) CANNOT generate a ringback tone in the same way as the telephone set of Maeda, because a VOIP network does not support the transmission of a "ringback" tone with encapsulating the "ringback tone data" into a VOIP message.

Accordingly, Maeda CANNOT be interpreted to suggest that the telephone set 10 generate "data" for the ring back tone, insert the data into a response message, and transmit the response message to the second terminal over the VOIP network, as recited in claim 1.

Further, Maeda directly teaches away from the first terminal initiating a call, as recited in claim 1. Maeda discloses that telephone set 10 (i.e., the first terminal) initiates a call. See column 3, lines 33-35. Claim 1, on the other hand, recites that the second terminal, and not the first terminal, initiates a call. For this reason alone, a person of ordinary skill in the art could not be motivated to combine Maeda with any other reference as the resulting combination would also teach away from the first terminal initiating a call, as recited in claim 1.

Maeda directly teaches away from the second terminal generating a ring back tone, as recited in claim 1. Maeda discloses that the telephone set 10 (i.e., the first terminal) generates a ring back tone. See column 4, lines 5-7. Claim 1, on the other hand, recites that the second terminal, and not the first terminal, generates a ring back tone. Therefore, a person of ordinary skill in the art could not be motivated to combine Maeda with any other reference as the resulting combination would also teach away from the second terminal generating a ring back tone, as recited in claim 1. Again, please note the difference between ring back tone data (i.e.,

information transmitted over a data communication network) and a ring back tone (i.e., sounds actually heard by a calling party).

Breeden fails to cure the deficiencies of Maeda as Breeden fails to teach or suggest (1) wherein the first terminal communicates over a voice over internet protocol (VOIP) network and the second terminal communicates over public switched telephone network (PSTN); (2) wherein the VOIP and the PSTN networks are connected by way of a trunk gateway; and (3) wherein the second terminal generates a ring back tone according to the ring back tone data included in the response message; (4) generating ring back tone data independently by the first terminal; (5) inserting the ring back tone data into a response message by the first terminal, in response to the call setup request; and (6) and transmitting the response message from the first terminal to the second terminal over the VOIP network," as recited in claim 1.

Breeden discloses generating a dial tone in response to receiving an authorization response. See column 5, lines 5-7. However, the dial tone and the authorization response disclosed in Breeden are not equivalent to the ring back tone and the response message recited in claim 1. It is respectfully noted that §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

Column 5, lines 6-9 of Breeden expressly disclose that the dial tone indicates that a calling party is allowed to dial a telephone number. Thus, the dial tone in Breeden is generated before the calling party dials a telephone number to initiate a call. The ring back tone in claim 1, on the other hand, is generated after the calling party initiates a call.

Column 4, lines 54-62 of Breeden expressly disclose that the authorization response indicates whether a calling party is authorized to operate in the system (i.e., whether the calling party is subscribed to a service provided). The response message in claim 1, on the other hand, includes ring back tone data.

Chung fails to cure the deficiencies of Maeda and Breeden as Chung fails to teach or suggest (3) wherein the second terminal generates a ring back tone according to the ring back tone data included in the response message; (4) generating ring back tone data independently by the first terminal; (5) inserting the ring back tone data into a response message by the first terminal, in response to the call setup request; and (6) and transmitting the response message from the first terminal to the second terminal over the VOIP network," as recited in claim 1.

Further, Chung directly teaches away from the first terminal independently generating ring back tone data, as recited in claim 1. Chung suggests that a ring signal (i.e., the ring back tone data) is generated by PSTN 114 and sent to the calling party. See paragraph [0023] and figure 3. In contrast, claim 1 recites that the ring back tone is independently generated by the by the first terminal without any help from a PSTN switchboard or access gateway. See Specification, paragraph [0052]. Therefore, a person of ordinary skill in the art could not be motivated to combine Chung with any other reference as the resulting combination would also teach away from the first terminal independently generating ring back tone data.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and

teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,[2] or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.[3]

Since no reasonable justification is provided in the Office Action as to how such modification is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 grounds of rejection be withdrawn.

For the above reasons, none of the cited references, either along or in combination, teach or suggest the claimed subject matter as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-8 depend from claim 1 and should be in condition for allowance by the virtue of their dependence on an allowable base claim. Claims 9 and 21 substantially incorporate the elements of claim 1; therefore, claims 9 and 21 and claims 10-16 depending from claim 9 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

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2 *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

3 "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Waimey

Date: January 9, 2009   By: __/F. Jason Far-hadian/_____

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